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			EXAMINER SHAH, AMEE A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/759,931
Filing Date: January 16, 2004
Appellant(s): ANDERS ET AL.

MAILED

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GROUP 3600

Robert A. Voigt, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 5, 2007, appealing from the Office action mailed September 6, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0039705	Svancarek et al.	2-2004
2002/0116312	Talbot et al.	8-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The ground(s) for rejection are reproduced below from the Final Office Action, mailed September 6, 2006, and are provided here for the convenience of both the Appellant and the Board of Patent Appeals:

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-4, 6, 9-13, 15, 18-22 and 25 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Svancarek et al., US 2004/0039705 A1 (hereinafter referred to as "Svancarek").

Referring to claim 1. Svancarek discloses a method for entitlement management comprising:

- responsive to a request for a service (page 3, ¶0031), determining if a recipient identified in said request is entitled to said service (page 4, ¶0034);
- if said recipient is entitled to said service, delivering said service (page 4, ¶0036),
- wherein said step of determining if said recipient is entitled to said service comprises comparing a set of administrator-configurable package profile attributes values associated with a package of services containing said service with corresponding values for said recipient (page 4, ¶0034 – note the attributes are contained in the eligibility service and can be a participating region or participating software product).

Referring to claim 2. Svancarek also discloses the method of claim 1 further comprising if, responsive to said determining step, if said recipient is not entitled, sending a message to said recipient indicating said recipient is not entitled to said service (pages 3-4, ¶¶0031, 0032 and 0035).

Referring to claim 3. Svancarek also discloses the method of claim 1 further comprising configuring said set of package attributes wherein said set of package attributes includes selected attributes having one or more attribute values (page 4, ¶¶0034, 0036 and 0037).

Referring to claim 4. Svancarek also discloses the method of claim 1 further comprising:

- determining if said service includes a limited number of accesses (pages 4 and 5, ¶¶0035 and 0042 – note the limited number of accesses is if the key was already used); and
- if said service includes a limited number of accesses, decrementing a tracking count associated with the service (page 5, ¶¶0042-0043).

Referring to claim 6. Svancarek further discloses the method of claim 2 wherein the step of sending said message comprises presenting said recipient with alternate content (page 4, ¶¶0032-0033 – note the alternate content is the website to which the user is redirected).

Referring to claim 9. Svancarek also discloses the method of claim 4 further comprising:

- logging a delivery of said service (Fig. 3 and pages 4-5, ¶¶0040-0042);
- decrementing a number of available instances of said service if said service has a limited usage count (Fig. 3 and page 5, ¶0042); and
- sending a message to said recipient indicating said recipient is not entitled to said service if the limited usage count has been consumed (page 4, ¶0035).

Referring to claims 10-13, 15, 18-22 and 25. All of the limitations in apparatus claims 10-13, 15, 18-22 and 25 are closely parallel to the limitations of method claims 1-4, 6 and 9, analyzed above and are rejected on the same bases.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

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differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8, 14, 17, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svancarek over Talbot et al., U.S. Pat. App. Pub. No. 2002/0116312 A1 (hereinafter referred to as "Talbot")

Referring to claims 5 and 8. Svancarek discloses the method of claim 1, as discussed above, wherein said substep of comparing a set of package profile attributes values associated with a package of services containing said service with corresponding values for said recipient comprises determining if said recipient is not entitled if a or each value of said current attribute and a corresponding value for said recipient miscompare (page 4, ¶0034). Svancarek does not expressly show determining if the current attribute is single-valued or not. Talbot, in the same field of endeavor of e-shopping, discloses a reverse blind credit auction between a borrower and at least one lender to which the borrower is matched using various criteria, including determining if the attribute value is single-valued or not (Talbot, page 4, ¶¶0043-0044 – note the attribute is the exclusion).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Svancarek to include the teachings of Talbot to allow for determining whether the current attribute is single-valued or not. Doing so would allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria, as suggested by Talbot (page 2, ¶0012).

Referring to claims 14, 17, 23 and 24. All of the limitations in apparatus claims 14, 17, 23 and 24 are closely parallel to the limitations of method claims 5 and 8, analyzed above and are rejected on the same bases.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svancarek

Referring to claim 7. Svancarek discloses the method of claim 6, as discussed above, but does not explicitly disclose wherein said alternate content includes a description of criteria for said requested service. As analyzed above, Svancarek shows presenting the recipient with alternate content when the recipient is not entitled to the requested service. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the presenting step recited. The data to be displayed when the recipient is found ineligible does not change the function being performed. The presenting of alternate content would be performed in the same manner regardless of the exact composition of the content, whether a message, an alternate website or a description of criteria. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Svancarek in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to present alternate content obtain when the recipient is ineligible for the service regardless of the specific composition of the content, whether a message, an alternate website or a description of criteria, because such content does not functionally relate to presenting step and also because the content to be displayed does not patentably distinguish the claimed invention.

Referring to claim 16. All of the limitations in apparatus claim 16 are closely parallel to the limitations of method claim 7, analyzed above and are rejected on the same bases.

(10) Response to Argument

10.1 Svancarek does not disclose “wherein said step of determining if said recipient is entitled to said service comprises: comparing a set of administrator-configurable package profile attributes values associated with a package of services containing said service with corresponding values for said recipient” (AP.B., pages 4-7).

The applicant argues that Svancarek does not disclose comparing a set of administrator configurable package profile attribute values with corresponding values for the recipient, nor comparing a set of administrator-configurable package profile attribute values associated with a package of services containing the service with corresponding values for the recipient (AP. B, pages 4-5). The applicant argues that the product key used in Svancarek which is used to activate a digital product/service is different than a package of services (AP. B, page 5). The Examiner disagrees; as applicant agrees, the product key is used to install and activate a software product or service (§0031), and therefore comprises a package of services, i.e. the software products/services to be installed.

In response to applicant’s argument regarding claims 1, 10 and 19 that Svancarek does not discloses comparing a set of administrator-configurable package profile attributes values with corresponding values for the recipient (AP. B, pages 5-6), the Examiner disagrees.

Applicant argues that Svancarek “simply discloses that an eligibility service 28 determined whether the user is qualified to obtain/purchase the desired product key” (AP. B., page 5), and therefore does not disclose determine eligibility by comparing a set of administrator-configurable package profile attribute values (AP. B., pages 5-6). Svancarek discloses determining eligibility by determining, for example, whether the customer is in a participating region and/or has a

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participating software product (§0034). The administrator-configurable package profile attribute values are the geographic region and software product, which correspond to the examples of attributes cited by applicant in the Specification (page 7). In order to determine whether the geographic region is participating, a comparison must be made between the recipient value for region and the package profile value for participating region. The participating region is inherently administrator-configured. Therefore, Svancarek discloses comparing a set of administrator-configured attributes (i.e. the participating geographic region and/or software product) with corresponding values for the recipient in order to determine eligibility.

In response to applicant's argument that Svancarek does not disclose a set of package profile attribute values associated with a package of services (AP. B, pages 6-7), containing the service with the corresponding values, the Examiner disagrees. The package of services, as discussed above, is within the product key which containing the service with corresponding values, and the package profile attribute values are the participating geographic region and/or software product.

10.2 Svancarek does not disclose configuring a set of package attributes (AP. B, pages 7-9).

In response to applicant's argument regarding claims 3, 12 and 21 that Svancarek does not disclose configuring a set of package attributes (AP. B, pages 7-9), the Examiner disagrees. As discussed above, the attributes as to which geographic locations and/or software programs are participating must be configured.

10.3 Svancarek does not disclose determining if the service includes a limited number of accesses (AP. B, pages 9-10), and if it does, decrementing a tracking count (AP. B, page 10).

In response to applicant's argument regarding claims 4, 13 and 22 that Svancarek does not disclose determining if the service includes a limited number of accesses (AP. B, pages 9-10), and if it does, decrementing a tracking count (AP. B, page 10), the Examiner disagrees. Svancarek discloses determining "whether the already-used product has previously resulted in the distribution of a set number of additionally product keys, such as for example 3-5. In such case, it may be that the customer should be directed elsewhere to obtain a volume license or a multi-machine license." (§0035) The set number of product keys is considered the limited number of accesses. The service is the product, which corresponds to applicant's definition of service in the Specification (page 2), and for which a product key, i.e. limited number of accesses, can be obtained. The determination if the service includes a limited number of accesses is the determining of whether the product has previously resulted in a set number of keys, i.e. a limited number of accesses, or whether there is a volume license, which is another limited number of accesses (§0035). Furthermore, the reporting service can track how many product keys have been distributed in connection with the product and the provider can track the history of the distributed product keys and enforce any business rules, i.e. create a tracking count (§§0040-0041). The activation database concomitantly receives such information and also tracks each delivered product key with regard to whether the key has been employed and determines whether each has been employed by updating the database as each key is used, i.e. decrementing the tracking count (§§0042-0043).

10.4 Svancarek does not disclose logging a delivery of a service, decrementing a number of available instances if there is a limited usage amount or sending a message to the recipient indicating the recipient is not entitled to the service if the usage count has been consumed (AP. B, pages 10-13).

In response to applicant's argument regarding claims 9, 18 and 25 that Svancarek does not disclose logging a delivery of a service, decrementing a number of available instances if there is a limited usage amount or sending a message to the recipient indicating the recipient is not entitled to the service if the usage count has been consumed (AP. B, pages 10-13), the Examiner disagrees. Svancarek discloses that the reporting service stores in a database information allowing the provider to track the history of the copy of the software product and distributed product keys, i.e. logging a delivery of service (§0041). As discussed above, Svancarek discloses determining whether there is a limited usage amount, a/k/a one or a set number of accesses, in that it discloses "whether the already-used product has previously resulted in the distribution of a set number of additionally product keys, such as for example 3-5. In such case, it may be that the customer should be directed elsewhere to obtain a volume license or a multi-machine license." (§0035) See 10.3 supra. As also discussed above, Svancarek discloses decrementing the number of available instances, i.e. accesses, if there is a limited usage amount, e.g. by decrementing a tracking count. See 10.3 supra. Furthermore, Svancarek discloses that if the recipient has exceeded his usage amount, a message is sent when the customer is directed elsewhere; thereby indicating that the recipient is not entitled to the service if the usage amount is consumed (§0035).

10.5 A.Svancarek in view of Talbot does not teach or suggest “wherein said substep of comparing a set of package profile attribute values associated with a package of services containing said service with corresponding values for said recipient comprises: for each profile attribute in a set of profile attributes, determining if a current attribute is single-valued; and if said current attribute is single-valued, determining said recipient is not entitled if a value of said current attribute and a corresponding value for said recipient miscompare” (AP. B, pages 13-15).

In response to applicant’s argument regarding claims 5, 14, and 23 that Svancarek in view of Talbot does not teach or suggest “wherein said substep of comparing a set of package profile attribute values associated with a package of services containing said service with corresponding values for said recipient comprises: for each profile attribute in a set of profile attributes, determining if a current attribute is single-valued; and if said current attribute is single-valued, determining said recipient is not entitled if a value of said current attribute and a corresponding value for said recipient miscompare” (AP. B, pages 13-15), the Examiner disagrees.

Applicant’s argue that Svancarek does not teach a set of profile attributes nor “determining if the recipient is not entitled if a value of the current attribute and corresponding value for the recipient miscompare if the current attribute is single-valued” (AP. B, page 14). As discussed above, Svancarek does teach a set of profile attributes. Svancarek also teaches determining is a recipient is not entitled if the values miscompare (§0034, “an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key ... [by determining] whether the customer is in a participating region and/or has a participating software product.”) If the recipient is not in a participating region and/or does not have a participating software product, i.e. the values miscompare, then the recipient is not entitled to purchase/obtain the service. Svancarek makes the determination for each attribute. Talbot

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teaches a reverse blind credit auction between a borrower and at least one lender to which the borrower is matched using various criteria, including determining if the attribute value is single-valued or not (§§0043-0044 – note the attribute is the exclusion). In response to applicant's argument that Talbot does not teach determining if a current attribute is single-valued (AP. B, pages 14-15), the Examiner disagrees. A determination as to whether a current attribute is single-valued is made when a determination is made as to whether a single value exclusion applies (Talbot, §§0043). If the single-valued exclusion applies, a second filtering process is performed (Talbot, §§0043). Therefore, Talbot teaches determining if a current attribute is single-valued, and if it is, performing a next process, taught by Svancarek, of determining a recipient not entitled to a service if the values miscompare.

10.5 B.Svancarek in view of Talbot does not teach or suggest “wherein said substep of comparing a set of package profile attribute values associated with a package of services containing said service with corresponding values for said recipient comprises: for each profile attribute in a set of profile attributes, determining if a current attribute is single-valued... and if said current attribute is not single-valued, determining said recipient is not entitled if each value of said current attribute and a corresponding value for said recipient miscompare” (AP. B, pages 15-16).

In response to applicant's argument regarding claims 8, 17, and 24 that Svancarek in view of Talbot does not teach or suggest “wherein said substep of comparing a set of package profile attribute values associated with a package of services containing said service with corresponding values for said recipient comprises: for each profile attribute in a set of profile attributes, determining if a current attribute is single-valued; ... and if said current attribute is not single-valued, determining said recipient is not entitled if each value of said current attribute and

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a corresponding value for said recipient miscompare” (AP. B, pages 15-17), the Examiner disagrees.

Applicant’s argue that Svancarek does not teach a set of profile attributes nor “determining if the recipient is not entitled if each value of the current attribute and corresponding value for the recipient miscompare” (AP. B, page 14). As discussed above, Svancarek does teach a set of profile attributes. Svancarek also teaches determining is a recipient is not entitled if the values miscompare (§0034, “an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key ... [by determining] whether the customer is in a participating region and/or has a participating software product.”) If the recipient is not in a participating region and/or does not have a participating software product, i.e. the values miscompare, then the recipient is not entitled to purchase/obtain the service. Svancarek makes the determination for each attribute. Talbot teaches a reverse blind credit auction between a borrower and at least one lender to which the borrower is matched using various criteria, including determining if the attribute value is single-valued or not (§§0043-0044 – note the attribute is the exclusion). In response to applicant’s argument that Talbot does not teach determining if a current attribute is not single-valued (AP. B, pages 14-15), the Examiner disagrees. A determination as to whether a current attribute is single-valued is made when a determination is made as to whether a single value exclusion applies (Talbot, §0043), and if the single-valued exclusion does not apply, whether multiple value exclusions apply (Talbot, §0044). Therefore, Talbot teaches determining if a current attribute is not single-valued, determining whether multiple value attributes apply, by, as taught by Svancarek, of determining a recipient not entitled to a service if each of the values miscompare.

10.6 Examiner's motivation is insufficient to establish a prima facie case of obviousness (AP. B, pages 16-19).

In response to applicant's argument regarding claims 5, 8, 14, 17, 23 and 24 that the motivation to combine is insufficient (AP. B, pages 16-17), the Examiner disagrees. The motivation to modify Svancarek to incorporate Talbot's feature may be another advantage than that which applicant intends. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the motivation to combine, i.e. rationale for combining the two references, is to filter criteria, such as geographic location or other criteria considered and allowed for in Svancarek, to better allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria, is sufficient.¹

10.6 Examiner's relies on a reference under 35 U.S.C. §103 that is not analogous prior art (AP. B, pages 19-20).

In response to applicant's argument that the Talbot referent is not analogous art to the Svancarek reference, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case,

¹ The Examiner is not required to, and will not, respond to applicant's hypothetical example contained in the footnote on page 19 as the Examiner is concerned only with the claims and argument presented by applicant as relevant to this invention.

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Talbot is in the analogous art of business methods relating to determining eligibility, i.e. screening, of persons, for products/services.

10.7 A. Improper Use of *In re Gulack* and *In re Lowrey* (AP. B, pages 20-21) and Examiner's motivation is insufficient to establish a prima facie case of obviousness (AP. B, pages 21-22).

In response to applicant's argument regarding claims 7 and 16 that the non-functional descriptive language must be given patentable weight (Remarks, page 25), and that the motivation to combine is inadequate (Remarks, page 26), the Examiner disagrees and states that *In re Gulack* and *In re Lowrey* were properly applied. As discussed in the previous office action and below, the data to be displayed when the recipient is found ineligible does not change the function being performed of displaying data. The presenting of alternate content would be performed in the same manner regardless of the exact composition of the content, whether a message, an alternate website or a description of criteria. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Svancarek in terms of patentability.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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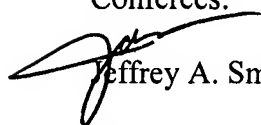
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

AAS

May 3, 2007

Conferees:



Jeffrey A. Smith, SPE 3625

Vincent Millin, Appeals Specialist



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